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Olivier J. Poncelet

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Eastman Kodak Company  
Patent Legal Staff  
343 State Street  
Rochester, NY 14650-2201

EXAMINER

JOY, DAVID J

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## DETAILED ADVISORY ACTION

### *Response to Applicant's Remarks/Arguments*

1. Applicant argues that neither Liu (the U.S. Patent of Liu et al., 6,548,149), nor Poncelet (the U.S. Patent of Poncelet et al., 5,916,946) clearly teaches or suggests the use of a hybrid aluminosilicate polymer obtained by the specified preparation method that is presently claimed, and that the rejection based upon those references represents clear error. However, Examiner respectfully disagrees with Applicant's assertion. There is nothing claimed in the *product* portion of the present claims that positively recites the presence of hydrolyzable and non-hydrolyzable substituent groups in the formed aluminosilicate polymer product. In addition, there is nothing taught by the present specification that defines what is meant by an ink jet recording element (i.e., the final product that is formed) having an ink-receiving layer that comprises at least one hydrosoluble binder and at least one *hybrid* aluminosilicate polymer. To a skilled artisan, the use of the terminology "hybrid" with regard to an aluminosilicate polymer product connotes that the organic and inorganic materials are chemically reacted or integrated, and there is nothing claimed that would lead such an artisan to conclude that claiming a hybrid aluminosilicate polymer requires that that polymer has retained both hydrolyzable and non-hydrolyzable substituent groups.

2. While Applicant argues that Liu and Poncelet disclose a different product than the product obtained by the specified preparation method that is presently claimed, Applicant has produced no dispositive evidence to support this position. The present claims are drawn to an article/product (“an ink jet recording element”) that comprises a polymer that is obtained by a specified preparation method. “The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). See MPEP §2113.

3. In addition, Applicant asserts that the aluminosilicate polymers are clearly distinct, since the claimed invention explicitly requires use of a hybrid aluminosilicate polymer prepared from a silicon compound having a non-hydrolyzable (and thus inherently retained) group which is not the case in either Liu or Poncelet. However,

inherency cannot be relied upon when it comes to the presence, or lack thereof, of a pivotal claim limitation, and, again, there is nothing positively recited in the *product* portion of the present claims that claims the presence of hydrolyzable and non-hydrolyzable substituent groups being retained in the formed aluminosilicate polymer product, and the specification fails to provide any support as to the final formed product.

4. Applicant also argues that there has been no reasonable motivation proposed for the proposed combination of references, that a prima facie case of obviousness for such combination has not been established, and that the rejection based upon that combination of references represents clear error. However, it was previously established that according to MPEP 2141.01(a), a reference may be relied on as a basis for rejection of an applicant's invention if it is "reasonably pertinent to the particular problem with which the inventor is concerned." A reasonably pertinent reference is further described as one which "even though it maybe in a different field of endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." Poncelet is, therefore, a reasonably pertinent reference, because it teaches the inclusion of a hybrid aluminosilicate polymer into a photographic element (i.e., an imaging element), which

is a function/feature that is especially pertinent to the invention at hand and Liu (which is drawn to an “ink jet recording material” which can also be deemed to be an imaging element).

*Terminal Disclaimer*

5. The terminal disclaimer filed on April 7, 2009 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of second Applicant No. 10/521,899, third Application No. 10/563,693, fourth Application No. 10/578,813, and fifth Application No. 11/573,148 has been reviewed and is accepted. The terminal disclaimer has been recorded.

/Callie E. Shosho/  
Supervisory Patent Examiner, Art Unit 1794